

II. REMARKS

Status of the Claims

Claims 1-5, and 28 are presented for reconsideration. Claims 30-32 were withdrawn by the Examiner and applicant continues to object to such withdrawal as indicated below.

Summary of the Office Action

Claims 1, 2, and 28 stand rejected under 35USC103(a) on the basis of the cited reference Martensson, European Patent Application, No. 414 365 in view of the disclosure of Norman (WO98/09414). Claims 3-5 stand rejected under 35USC103(a) based on the reference Martensson in view of the cited reference Norman, and further in view of the admitted prior art (page 8-9 of the subject application). The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

Applicant again requests that the election requirement with respect to claims 30-32 be reconsidered. The subject matter of these claims relates to adding components to the basic invention as defined in claim 1. Claims 30 and 31 are depending claims written to appropriately depend on claim 1, and claim 32 depends on claim 30. The invention, at least in part, concerns the most optimal way of placing the components of a portable telephone apparatus into its two major parts, and claims 30-32 only serve to further define how certain additional components are accommodated in the two major parts.

In answer to the Examiner's question in section 6 of the Office Action, the link between a display and an antenna is that they

are both relatively space-consuming components of a portable telephone apparatus. The design of a portable telephone needs to take into consideration the distribution of the components of the portable telephone apparatus in order to establish an appropriate overall configuration of the components. In this instance the depending claims served to further define the portable telephone apparatus that was more generally defined in claim 1. This is an appropriate use of a depending claim and does not constitute a separate specie. The Examiner's position would seem to rule out depending claims in general.

Discussion of the Cited Reference

The Examiner relies on the reference Martensson as primary support for the rejection based on obviousness.

Martensson discloses a sleeve-like grip part 7 and a releasing actuator 14, but, as admitted by the Examiner, actuator 14 is not located in the sleeve-like grip part 7, but in the main body 2 of the telephone apparatus. This was one of the drawbacks of the prior art solution of Martensson, and a motivating factor for developing the new invention described in the present application.

As the result of a merger of corporate assets, the cited reference Martensson is also owned by Nokia Corporation, the assignee of the subject application. The subject application and the cited reference were therefore commonly owned at the time this invention was made.

The rejection under 35USC103(a) combines the teaching of Martensson with the references Norman and so called admitted

prior art. The reference Martensson, however, is not a proper reference under 35USC103c because it is owned by Nokia Corporation, the owner of the subject application, and is prior art based on 35USC 102(e). Section 103(c) specifically indicates that such a reference will not preclude patentability where the subject matter of the reference was commonly owned at the time of the invention.

Nevertheless, for the reasons described above, the disclosure of the reference Martensson does not support the Examiner's rejection based on obviousness.

The disclosure of the reference Norman does not remedy the deficiencies of the cited reference Martensson. The device of Norman does not use a sleeve-like grip part, but involves a sliding cover 14 that is not intended to be grasped, but slides to expose user interface console 16. In addition, the cover 14 is released by means of a mechanism 95 actuated by release button 96 located in the phone body 12. This is a release actuator configuration similar to that used in the device of Martensson and therefore does not add to the disclosure of Martensson. The teaching of the reference Norman, therefore, does not support the Examiner's position.

The Examiner characterizes the disclosure of Norman as follows:

"However, Norman teaches providing a user-actuatable releasing actuator (96) which is mounted in the grip part (12) for releasing the mechanism"

This is accurate as far as it goes, but the statement ignores the fact that the "grip part 12" is actually the body of the telephone. It is not the same as the sleeve-like grip part of

the subject invention. The housing 12 of Norman cannot be both the grip part of the subject invention, from which the body of the phone is extended, and the body of the phone itself. As indicated above the release actuator button is constructed in the element 12 which is the body of the phone. The Examiner's position, therefore, is unsupported. The release button of Norman is no different than the release button of Martensson.

As indicated above, the subject invention, as defined in the claims, is directed to providing a protective sleeve-like grip part which, in the open position, provides a firm support for the phone by which the phone is held. In the closed position, the entire phone is enclosed. This design is completely missing from the teaching of Norman. Thus, Applicant questions, what kind of combination a person skilled in the art could make from the teachings of Martensson and Norman. It is in any case certain that no combination of teachings of the two reference publications would result in a device having a release actuator within a sleeve-like grip part, as described in the claims under consideration.

The Examiner describes the disclosure of this application contained at page 8, line 35 through page 9, line 6, as "admitted prior art". This refers to alternatives in linking the release actuator and cites mechanisms used in holders for mobile phones used in automobiles, as examples. Nothing in this disclosure remedies the deficiencies of the teachings of the cited references Martensson and Norman.

The Issue of Obviousness

It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when

combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application.

Applicant submits that the above described deficiencies of the primary reference Martensson are not remedied by the proposed combination with the teaching of the reference Norman or the so called "admitted prior art". The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Martensson or Norman, in order to obtain the invention as described in the claims, submitted herein, would not have been obvious to one skilled in the art.

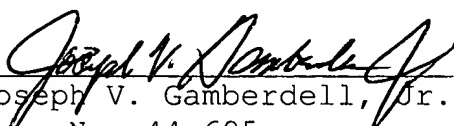
With respect to the rejection of claims 4 and 5, the Examiner has not considered the claims as whole, but relies on the disclosure by Applicant of analogous art relating to the linkage of release actuators in general. For the reasons indicated above the totality of claims 4 and 5 are not rendered obvious by the "admitted prior art".

Applicant submits that the addition of figures 6c and 6d is fully supported in the specification and does not add new matter, whether or not the "admitted prior art" is significant to patentability.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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3 June 2005
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